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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/987,468	12/10/1997	HEINRICH GERS-BARLAG	BEIERSDORF	6313

7590 07/08/2004
NORRIS MCLAUGHLIN & MARCUS, P.A.
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NEW YORK, NY 10017

EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/987,468

Applicant(s)

GERS-BARLAG ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the amendment filed 12/29/03 and the corrected amendment filed 3/17/04. Claims pending are 31-48. Claims 1-30 have been cancelled.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 31, 32, 36-41 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allard et al. (US 5,616,331) in view of either Kumano et al. ("Studies of water-in-oil (w/o) emulsion stabilized with amino acids or their salts", J. Soc. Cosmet. Chem., 28, No. 5, 285-314, 1977) or Robinson et al. (US 5,306,485).

Allard et al. teach sunscreen compositions in the form of o/w emulsions containing inorganic nanopigments, either hydrophobically coated or uncoated, which may be present in the oil phase, or in the aqueous phase of the emulsion, or even in both phases at the same time. See Abstract; col. 3, lines 8-48. The emulsions may also contain organic sunscreen agents such as, for example, 2-phenylbenzimidazole-5-sulfonic acid and salts thereof. See col. 3, lines 54-60. The emulsions of Allard et al. contain 0.5-20% of emulsifiers, such as fatty acid esters of polyols (i.e. compounds prepared by reacting a fatty acid such as stearic or oleic acid, with a polyol such as glycerol or polyglycerol). See col. 5, lines 41-43; col. 6, lines 25-29. The emulsions are applied to the skin for the photoprotection of the skin. See Abstract. The method of Claim 39 is inherent to the reference because the reference teaches the same method

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step as claimed in the instant claim, that is, incorporating a superficially hydrophobic inorganic pigment into the oil phase of the emulsion. See Examples. While teaching all the claimed ingredients, the reference does not teach the claimed water-in-oil emulsions. However, either type of emulsions is well known in the art of cosmetic compositions. Kumano et al. teach that w/o emulsions are more advantageous to skin than o/w emulsions because they have better skin protecting and moisturizing properties than o/w emulsions. See p. 285. Robinson et al. teach w/o emulsions containing oil-soluble sunscreens provide better sunscreens efficiency than o/w emulsions containing oil-soluble sunscreens. See col. 2, lines 33-40. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the emulsions of Allard et al. such that to make w/o emulsions. One having ordinary skill in the art would have been motivated to do this to obtain better skin protection and moisturizing as suggested by Kumano et al. or better sunscreens efficiency as suggested by Robinson et al.

3. Claims 33-35 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allard et al. in view of either Kumano et al. or Robinson et al. as applied to claims 31, 32, 39 and 41 above, and further in view of either Billia et al. (US 5,486,353) or Robinson et al.

Allard et al. in view of either Kumano et al. or Robinson et al. applied as above. Allard et al. do not explicitly teach the emulsifiers of Claims 33-35 and 42-44. However, polyglyceryl 4-isostearate of Billia et al. or Robinson et al. are used in the art of

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sunscreening cosmetic compositions for the same art-recognized purpose as fatty acid esters of polyols disclosed by Allard et al. See, for example, Billia et al., Examples 1-3; Robinson et al. at col. 15, Example V. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use polyglyceryl 4-isostearate of Billia et al. or Robinson et al. in emulsions of Allard et al. for their art-recognized purpose with a reasonable expectation of achieving the same stabilizing effect as set forth in the Allard reference.

Conclusion

4. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ml

6/30/04


MICHAEL G. HARTLEY
PRIMARY EXAMINER